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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/652,166

08/31/2000

Paul Chan H. Tse

NORT-0067
(12825RRUS01U)

2631

7590

01/25/2005

EXAMINER

FOSTER, ROLAND G

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ART UNIT

PAPER NUMBER

2645

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/652,166

Applicant(s)

TSE, PAUL CHAN H.

Examiner

Roland G. Foster

Art Unit

2645

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

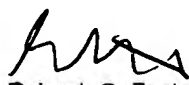
Claim(s) allowed: 18.

Claim(s) objected to: _____.

Claim(s) rejected: 1-6, 8-17 and 19-42.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


Roland G. Foster
Primary Examiner
Art Unit: 2645

1/17/05

Continuation of 2. NOTE:

Applicant's proposed amendment raises new issues that would require further consideration and search. For example, applicant's amendment makes claims 2-5 newly dependent from old dependent claim 33 in the original limitations therein, resulting in a new combination of limitations (in this case a different and more detailed invention) that has not previously set forth and/or considered.

Applicant's argues that the claim 33 rejection is defective because the examiner provided no explanation, thus the rejection fails to establish a prima facie case of obviousness.

Applicant's argument has been considered but is not deemed fully persuasive.

First, claim 33 was statutorily rejected under 35 USC 103 (see page 11 of the last Office action).

Second, the limitation recited by claim 33 is clearly disclosed by the base reference Nelson and thus requires no explanation and no obviousness inquiry (e.g., whether a prima facie case has been established). A cursory review of either the examiner's rejection or Nelson would have provided the applicant with notice of how Nelson discloses the limitation in claim 33, especially since claim 33 barely distinguishes over parent, independent claim 1. Specifically, parent, independent claim 1 recites communicating voice data over a packet-based network and dependent claim 33 merely adds that this voice over packet communicating uses an "Internet Protocol Network" (e.g., a particularly notorious example being the Internet). In addressing how Nelson disclosed certain limitations in the independent claims, the examiner expressly explained how Nelson disclosed BOTH the communication of voice data over a packet based network and that the communication used the Internet 40 (an "Internet Protocol Network") (see page 11 and then page 10 of the last Office action). Even if the applicant were to have missed this explanation, a cursory review of Nelson would have revealed (again not surprisingly) that voice over packet data is communicated via Internet 40 (Fig. 1).